Remarks

Claims 34, 35 and 163-170 are pending in the Application.

Claims 34, 35, 163-166 and 168-170 are rejected.

Claims 35 and 167 are objected to.

Claim 35, 167 and 163 are amended herein.

I. REJECTIONS UNDER 35 U.S.C. § 103(a) OVER LI

Examiner has rejected Claims 34, 35, 163-166 and 168-170 under 35 U.S.C. § 103(a) as obvious over Li et al., "Large-Scale Synthesis of Aligned Carbon Nanotubes," *Science*, Vol. 274, December 6, 1996, pp. 1701-1703 ("*Li*"). Office Action at 2. Applicant respectfully traverses these rejections.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *See* M.P.E.P. 706.02(j); *see also In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

<u>Claim 34</u>. Claim 34 claims a method for forming macroscopic molecular array of tubular carbon molecules, said method comprising the steps of:

- a) providing a nanoscale array of microwells on a substrate;
- b) depositing a metal catalyst in each of said microwells; and
- c) directing a stream of hydrocarbon or CO feedstock gas at said substrate under conditions that effect growth of single-wall carbon nanotubes from each microwell.

With regard to Claim 34, Li does not teach such a method for forming an array of tubular carbon molecules. First of all, Li does not provide a nanoscale array of microwells on a substrate. The substrate of Li is mesoporous silica, a three-dimensional surface with a large surface area derived from the mesopores. Such silica is amorphous and has randomly-arranged pores formed from interconnecting, generally round spaces in the silica. As such, the pores have different, sizes, shapes and pathways through the silica. "The growth direction of the nanotubes may be controlled by the pores from which the nanotubes grow." See Li, Abstract, p. 1701. Thus, Li teaches nanotubes growing in all directions throughout and from a three-dimensional porous surface. Since the pores are not regularly-spaced or directed, such pores would not be considered an array. Furthermore, such irregularly-shaped pores could not be considered microwells, which are ordered arrays of regularly-shaped wells. Thus, there is no suggestion or motivation, either in Li or in the knowledge generally available to one of ordinary skill in the art, to modify Li to provide an array of microwells on a substrate.

Furthermore, Li does not deposit metal in each of said microwells. Li mixes a metal salt with a sol-gel to form mesoporous silica with metal oxide embedded in the pores. Thus, Li does not teach or suggest depositing metal catalyst in each of said microwells. Depositing metal catalyst on mesoporous silica could even compromise the pore structure of the mesoporous silica of Li. Thus, Li does not teach or suggest microwells, and there is no suggestion or motivation is provided in Li or in the knowledge generally available to one of ordinary skill in the art to modify Li to deposit metal catalyst in an array of microwells on a substrate.

Furthermore, Li does not teach or suggest a method for growing single-wall carbon nanotubes from a microwell. The nanotubes of Li are multi-wall carbon nanotubes and oriented in all directions through and from a three-dimensional mesoporous silica support. That Li makes large-diameter multi-wall carbon nanotubes is supported by Figure 3 of Li which states "The tube is well graphitized and consists of about 40 concentric shells of carbon sheets with spacing between the sheets of 0.34 nm. The inner and outer diameters of the tube are 3 and 34, nm, respectively." Further evidence that Li teaches multi-wall nanotubes is found in Li, p. 1703, col.

1, par. 1, "The smallest diameter of carbon nanotubes prepared by our method to date is ~ 10 nm."

Examiner has noted, "Li does not emplify SWNTs but indicates on page. 1703 (left) that they could be made by optimizing conditions for their growth." Office Action at 2. However, Li states "We believe that it is possible to produce arrays consisting of very thin, and possibly even single-layered carbon nanotubes, by improving growth conditions." Li at Col. 1, p. 1703. However, Li does not give any direction or insight how this might be done; rather Li only states that it is a "possibility." Id. A particular parameter must first be recognized as a result-effective variable, that is, a variable that achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as obvious. M.P.E.P. § 2144.05; see also In re Antonie, 559 F.2d 618 195 U.S.P.Q. 6 (C.C.P.A. 1977).

Moreover, this argument by the Examiner is basically that it would have been obvious "to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful"; such an argument is an improper *obvious to try* rational that has been flatly rejected by the Federal Circuit and its predecessor courts. M.P.E.P. § 2145(X)(A); see also In re O'Farrell, 853 F.2d 894, 903, 7 U.S.P.Q.2d 1673, 1681 (Fed. Cir. 1988) (and cases cited therein). It is well settled that the "admonition that 'obvious to try' is not the standard under § 103." *Id*.

Taken as a whole, Li does not suggest or provide all the claimed elements of Claim 34, and, furthermore, there is no suggestion or motivation in Li or in the knowledge generally available to one of ordinary skill in the art to form microwells on a surface and grow single-wall carbon nanotubes from each microwell.

Therefore, as a result of the foregoing, Applicant respectfully notes that a *prima facie* case of obviousness has not been established, and respectfully requests that the Examiner withdraw his rejection of Claim 34 under 35 U.S.C. § 103(a) as being anticipated by *Li*.

<u>Claim 163</u>. Claim 163 claims a "method for forming a macroscopic molecular array of single-wall carbon nanotubes comprising:

- (a) providing an array of a plurality of metal catalysts on a substrate; and
- (b) directing a stream of carbon containing feedstock gas at the substrate under conditions for growing single-wall carbon nanotubes from at least one of the plurality of the metal catalysts."

With regard to Claim 163, Li does not teach a method for forming an array of single-wall carbon nanotubes. First of all, Li does not provide an array of metal catalysts on a substrate. As stated above, the substrate of Li is mesoporous silica having embedded iron nanoparticles. See Li, Abstract on p. 1701. In Li, iron particles are embedded in a three-dimensional amorphous surface. In such silica support, the iron particles would be randomly distributed. A random distribution would not qualify as an array. The word "array" is generally defined as "An orderly arrangement," in *The American Heritage Dictionary, Second College Edition*, Houghton Mifflin Company, Boston, 1982. (See Exhibit A.) Since the catalyst metal of Li is embedded in an amorphous support having randomly-arranged pores formed from interconnecting spaces, the catalyst metal that is embedded in it, would also be randomly distributed in the silica. Such random distribution would hardly qualify as an array or "orderly arrangement." Furthermore, there is no suggestion or motivation, either in Li or in the knowledge generally available to one of ordinary skill in the art, to modify Li to provide an array of a plurality of metal catalysts on a substrate.

Moreover, as stated above, Li does not teach or suggest a method for growing single-wall carbon nanotubes, let alone, a macroscopic molecular array of single-wall carbon nanotubes. In fact, Li actually teaches away from the formation of an array with the deposition of metal catalyst on a substrate. When Li tried to grow nanotubes to form an array on a quartz plate coated using an iron nitrate solution that had been dried and reduced, Li did not form an array of any nanotubes, but a rather thick layer of multiwall nanotubes (30 nm in diameter) that grew randomly to form the thick layer. See Li, Col. 3, page 1702.

Taken as a whole, Li does not teach all the claimed elements of Claim 163, and, furthermore, there is no suggestion or motivation in Li or in the knowledge generally available to one of ordinary skill in the art to form a macroscopic molecular array of single-wall carbon nanotubes.

Claims 164-166 and 168-170 depend either directly or indirectly from Claim 163, and thus, Claims 164-166 and 168-170 are also not obvious for the same reasons Claim 163 is not obvious over *Li*. Furthermore, in addition to the lack of elements in *Li* and the lack of motivation and suggestion in *Li*, the dependent claims also have further distinguishing features. With regard to Claims 165-166, as stated above, *Li* does not teach or suggest an array of microwells. Regarding Claim 169, *Li* does not teach or suggest "catalysts in the form of pre-formed nanoparticles." Regarding Claim 170, *Li* does not teach or suggest microwells, let alone "at least about one million microwells."

Further, regarding Claim 170, the Examiner cites *In re Rose* 220 F.2d 459, 105 U.S.P.Q. 237 (C.C.P.A. 1955) for the proposition that "the number of catalyst islands used does not impart patentability." As binding case law and the M.P.E.P. reflect, this is a misstatement of the law, and the Examiner's reliance on *In re Rose* to make these obviousness rejections is misplaced.

The Federal Circuit and its predecessor court have long recognized that a claim, while not anticipated, can be held to be obvious when the *only* difference between the prior art and the claims was a recitation of relative dimension of the claimed invention *and* the invention having the claimed relative dimensions would not perform differently than the disclosure in the prior art reference. M.P.E.P. § 2144.04(IV)(A) (citing *In re Rose*, 220 F.2d 459, 105 U.S.P.Q. 237); *See also Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 1345, 220 U.S.P.Q. 777, 783 (Fed. Cir. 1984).

As noted above, there are differences between the prior art and the Claim 170 that go well beyond dimensional differences. Thus, the claimed invention is not simply increasing the number of microwells. Rather, it is the creation of a new and non-obvious method. The non-obviousness of the claimed invention under the present circumstance is in complete accord with Federal Circuit and its predecessor court's long standing precedent, which reflects that when the size or amount of the invention leads to compositions that have unique and novel properties and

use (and also when something is produced that theretofore had not been able to be accomplished), that such an invention was non-obvious and patentable. See In re Kirke, 40 F.2d 765, 767, 5 U.S.P.Q. 539 (C.C.P.A. 1930); see also Gardner, 725 F.2d at 1345, 220 U.S.P.Q. at 783.

Therefore, as a result of the foregoing, Applicant respectfully notes that a *prima facie* case of obviousness has not been established, and respectfully requests that the Examiner withdraw his rejection of Claims 163-166 and 168-170 under 35 U.S.C. \S 103(a) as being anticipated by Li.

IV. CLAIMS OBJECTED TO

Examiner has objected to Claims 35 and 167. The reasons for the objections were not given, however, it is expected that the objections are due to the claims being dependent upon a rejected claim. Thus, Claims 35 and 167 have been rewritten in independent form including all the intervening dependencies.

IV. OTHER CLAIM AMENDMENT

Claim 163 was amended to correct an inadvertent omission in the claim by adding the word "and" between the end of element (a) and the beginning of element (b). No new matter was added by way of this amendment.

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¹ The holding in *In re Rose* is premised upon the Court of Custom and Patent Appeal's opinion in *In re Kirke. See In re Rose*, 220 F.2d at 463, 150 U.S.P.Q. at 240 citing *In re Yount*, 171 F.2d 317, 318, 80 U.S.P.Q. 1441, 143 (C.C.P.A. 1948), which in turn cited *In re Kirke*, 40 F.2d 765, 5 U.S.P.Q. 539, all of which when discussing the implications of a change of size or amounts for potential inventions.

V. <u>CONCLUSION</u>

As a result of the foregoing, it is asserted by Applicant that the Claims in the Application are now in a condition for allowance, and respectfully request allowance of such Claims.

Applicant respectfully requests that the Examiner call Applicant's attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

Respectfully submitted,

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arraign (>18n') Ir.v. raignod, raigning, raigna. 1. Low. To call before a court to answer to an indictment. 2. To call to account: charge: "Johnson arraigned the madern publics of this country as entirely devaid of all principle" (Boswell). [ME arreinen < OFt. araisnier < VLat. "adrationare: Lat.

of this country as entirely devoid of all principle" (Bosswill). [AE arreines < OFT: arasinier < VLat. "advationare": Lat. do, of Lat. ratio, account. "see RESON.] —arreinginger n. do, to + Lat. ratio, account. "see RESON.] —arreinginger n. do, and the proper for controlling the proper for a profile. 3. To agree about; settle: "It has been arranged for him by his family to marry a girl of his one lass" (Edmund Wilson). 4 Mex. To reset (music) for other instruments or voices or for another style of performance. "int." 1. To cource to an agreement. 2. To make preparations: plan: arrange for a subbatical. (ME uranger < OFT, ample: 4. to (< Lat. ad) + rengier, to put in a line < reng. line. of Germanic orig.] —arrenger n. arrange ment (3-ran) month n. 7. The act of process of arranged. disposal. 3. A collection or set of things that have been arranged. 4. Often arrangements. A provision or plan mode in preparation for an undertaking. 5. An agreement siple or level of difficulty. b. A composition so arranged. Arranged. 4. Often arrangements. A provision or plan mode in preparation for an undertaking. 5. An agreement arranged. Arranged. 4. Often arrangements. A provision or plan mode in preparation for an undertaking. 5. An agreement siple or level of difficulty. b. A composition so arranged. Arranged. Arranged. Being completely such: thoroughgoing: arranged arranged. Arranged. Being completely such: thoroughgoing: arranged arranged attive; finery. 2. A wall hanging, esp. of uperty. [ME. after Arras, Feance.]

Briay (5-r8) 1r. V. -rayed, -raying, -rays. 1. To arrange or draw up, as troops in battle order. 2. To deck in finery; about. — n. 1. An orderly arrangement, esp. of troops. 2. An impressive display of numerous persons or objects: "a kethenih array of monstrous clubs and spears" (Melville. 3. Splendid attive; finery. 4. Manh. a. A rectangular prangement of quantities in rows and columns, as in a mattle, b. Numerical data linearly ordered by magnitude. 5. An arrangement of computer memory elements in one or seco

bridly (the attention, for example); engage, —n. 1. a. The sta of artesting, b. The state of being arrested. 2. A device for treating motion, esp. of a moving part. — kilom under smet. Detained in legal custody. [ME arcster < OFr. are set Vlal. "arrestare"; Lut. od. 10 ÷ Lut. rettare, to stand of the state of the state. fill (re. back + stare, to stand).] —ar-rester n. —ar-rest

arresting (a-resting) adj. Attracting and holding the atten-

armsung (3-testing) asy. Attracting and notating the atten-tion; sining,—arrowing-ty adv.

schiff-mise (3-tith mis-3) n. Any irregularity in the force or styling of the heartbeat. [Ok. arrathmia, lack of rhythm.] andbox, unrhythmical; a., without + rhuthmos, thythm.] schiff-mise (3-rith mis) also sershythmiseal (-misks) adj. Licking thythm or regularity of rhythm.—arrayithmiseal-ty-

arthro-han (are-ar-ban', -ban') n. 1. In medicual France, a total produmation by which vassals were summoned to without service. 2. The vassals summoned by an arribban [Fr. C OFr. orier-ban, alteration of Aerban, of Cier-

bebas. [Fr. < OFr. ariere-bun, alteration of herban, of Gercanic orig.]

arthre-pen-see (\$a'\tilde{a}\tilde{a}'\tilde{a}\tilde{m}\tilde{

(>-10'bs) n. Archaic. 1. A unit of weight in Spanishpeding countries equal to about 25 pounds, 2. A unit of weaping countries equal to about 25 pounds, 2. A unit of weaping countries equal to about 32 words, 2. A unit of weaping to Portuguese-speaking countries equal to about 32 words, 3. A liquid measure used in Spanish-speaking weating, having varying value, but approximately oqual to ill parts when used to measure wine. [5p. and Port. < Ar. 1946, the quarter (of a quintal).] arro-gance (ur's-gans) n. The state of quality of being arro

arrogant (ar a-gans) in the same of quanty artering are arrogant (ar a-gans) adj. 1. Overly convinced of one's own importance; overbearingly proud; haughty. 2. Characterized by or arising from haughty self-importance, [Mf. arrogans offer. 1. Lt. arrogans, pr.part. of arrogans, convergence (ar a-gail of the arrogans) arrogans (ar a-gail of the arrogans). To claim, take, or assume for oneself without right. 2. To attribute to another unwarrantably. [Lat. arrogans, transpart. ad., to + rogans, to ask.]—arrogafton n.—arrogafter adj.—arrogafter n. arrogafter (b-to) dissembly) n. 1. The chief administrative subdivision of a department in France. 2. A municipal subdivision of some large French cities. [Fr. arrondir, to round out: d to (< Lat. ad) + tandir, to make round.]

arrindir, to round out: à to (< Lât. ad) + randir, to make round.]

arrow (aro) n. 1. A straight, thin shalt that is shot from a how and usually made of light wood with a pointed head at one end and flight-stabilizing feathers at the other. 2. Something stmilar to an arrow in form, function, or speed. 3. Asign or symbol shaped like an arrow and used to indicate direction. [ME arwe < Ob trees.]

arrowhead (arō-lièd') n. 1. The pointed, removable striking tip of an arrow. 2. Something shaped like an arrowhead, such as a mark indicating a limit on a drawing. 3. Any aquatic or marsh plant of the genus Sagituria, having arrowhead-shaped leaves and white flowers.

arrowroot (arō-rōo). ...our) n. 1. A trupical American plant, Maranta arundinaced, having roots that yield an edible starch. 2. The starch from the arrowroot and from certain plants of the genera Manhat. Curcuma, and Taca. [Socilled because it was used to draw poison from arrow wounds.]

womens, arrow-wood (\$f'(-w(\tilde{o}d') n. Any of several small shrubs of the genus Viburnum, such as the dockmackie, having straight (ough stems formerly used by the Indians to make

straight lough stems formerly used by the Indians to make arrows.

Any of various small, slender marine worms of the phylum Chaetognatha, having prehensile bristles on each side of the mouth.

Broy'o (2-foi'0) n. pl. -0s. 1. A deep gully out by an intermittent stream; dry gulch. 2. A brook or creek. [Sp., ult. < Lat. arragia, mineshaft, a res (4rs) u. Chieffy Brit. Variant of assz.

Broad (3r's>-nal) n. 1. A governmental establishment for the storing, manufacturing, or repairing of arms, ammunition, and other war matoriel. 2. A stock of weapons. 3. A store or supply: She arrived with an arsenal of assistants. [Ital. arsenale < Ar. dür-ay-yindah : ddr. house + ap., the + sindah, manufacture < sanda, he made.]

Broad-nile (3r's>-nil., -nil') n. 1. A highly poisonous metallic element having three ullotropic forms, yellow, black, or gray, of which the brittle, crystalline gray is the most conumon. Arsenic and its compounds are used in insecticides, weed killers, solid-state doping agents, and various alloys. Atomic number 3s; atomic weight 74-922; valence 3 or 5. Gray arsenic melts at 817°C (at 28 arm pressure), sublimes at 613°C, and has a specific gravity of 5-30. 2. Arsenic trioxide. --adj, arsende (3r-sen'lk). Of or containing arsenic cisp, with valence 5. [ME arsenik < OFr. < Lat. arrenteum < Gk. arsenikon, yellow orpinent < Pers. carnik < zar, gold.]

Broad-le acld (ür-sen'lk-ol) udj. Of or containing arsenic, --n.

nates.

arsemi-cal (ar-sen?-kal) adj. Of or containing arsenic, —n.

A drug or preparation containing arsenic.

arsemic trioxide (arsenit) n. A poisonous white amorphous powder, As₂O₃, used in insecticides, rat poison, and weed killers.

arsemide (arsenid) n. A compound of arsenic with a more descriptionally element.

more electropositive element. rrse-nl-ous (ar-se'nê-əs) adj. Of or containing arsenic, esp.

with valence 3.

with valence 3.

Brae-no-pyrite (Br'so-nō-pi'rit') n. A silver-white to gray arsenic ore, essentially FeS₂-FeA₂, ar-shin (Br-shēn') n. Variant of archine, ar-shin (Br-shēn') n. A colorless, flammable, very poisonous gas, Asti, used as a military poison gas, as a solid-state doping agent, and in organic synthesis. [ABS(BNIC) + -1NP3.]

-ini3.]
serials (3r/sis) m. pl. -son (-sez). 1. Originally, the unaccented or shorter part of a foot of verse. 2. In modern usage, the accented or longer part of a foot of verse. 3. Max. The upbeat or unaccented part of a measure. [Llant, raising of the verice < Gk. upward beat < activities. in lift.]
serson (3r son) n. The crime of multiclously setting fire to the buildings or property of another or of burning one's own property for sonte improper purpose, as to collect insurance. (AN < OFT, argun < Med. Lat. arxio < Lat. ardêre, to burn! — argann! at n.

-ar son-ist n

ourn. —arsonist n. arryhen-simne (Br.-fcn's-men') n. A yellow hygroxonpic powder. C₁₇H₁₁N₂O₂As:2HCF-2H₂O. formerly used to treat syphilis. [ARS(ENIC) + PIEN(YL) + AMINE.] art'(Br.) a 1. Human effort to imitate, supplement, after, or

pa/rroor/s wavec/sh ship, dish/1 right/th thin, path/th this, hathe/û cut/ûr urge/v valve/w with/y yes/z zehra, size/ ism/sebout, item, edible, gallop, citcus / œ Fr. lea, Ger. schün / ü Fr. tu, Ger. über / кн Ger. ich, Scor. weh/ n Fr. bon.



arrowhead Above: Tip of an arrow Below: Savittaria larifolla